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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,164	12/31/2003	Gary F. Dandreaux	C-477	1558

7590 10/25/2006

Sun Chemical Corporation
222 Bridge Plaza South
Fort Lee, NJ 07024

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,164

Applicant(s)

DANDREAUX ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 8/9/06.

The new grounds of rejection set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5-6, 9, 16, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 has been amended to recite that the rosin-based resin is present in amount of "more than" 0 wt.% to about 40 wt.%, claim 9 has been amended to recite that the alcohol solvent is present in amount of "more than" 0 wt.% to about 35 wt.%, claim 16 has been amended to recite that the plasticizer is present in amount of "more than" 0 wt.% to about 40 wt.%, and claim 18 has been amended to recite that the latex emulsion is present in amount of "more than" 0 wt.% to about 40 wt.%". It is the examiner's position that these phrases fail to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the above phrases in the application as originally filed, *In*

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re Wright, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed

While there is support on page 6, lines 16-20 of the specification as originally filed to recite that the rosin-based resin is present in amount of 0 wt.% to about 40 wt.%, up to about 35 wt.%, and about 15wt.% to about 25 wt.%, there is no support in the specification as originally filed to recite that the lower limit of the amount of rosin-based resin is “more than 0 wt.%” as now required in present claim 5. Similarly, while there is support on page 6, line 23-page 7, line 7 of the specification for the recitation of the lower limit of alcohol, plasticizer, and latex emulsion of “about 0 wt.%”, there is no support in the specification as originally filed to recite that the lower amount of alcohol solvent, plasticizer, and latex emulsion is “more than 0 wt.%” as now required in present claims 9, 16, and 18, respectively.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 3-6, 8-10, 12-13, 15-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Krishnan et al. '022 (U.S. 6,444,022) in view of *Hawley's Condensed Chemical Dictionary*

Attention is drawn to example 2 of Krishnan et al. '022 that disclose lithographic composition comprising (i) 60% carbon black base comprising 40% carbon black, 20% rosin

ester, and 3% monoethanolamine, (ii) 20% modified linseed oil comprising 27.94% polyethylene glycol and 16.2% phthalic anhydride, (iii) 25% latex, and (iv) 2% monoethanolamine. From this example, it is calculated that the ink comprises approximately 24% carbon black, 12% rosin ester, 3.8% monoethanolamine, 5.6% polyethylene glycol, 3.24% phthalic anhydride, and 25% latex. It is well known, as evidenced by *Hawley's Condensed Chemical Dictionary* (pages 878-879), that phthalic anhydride functions as a plasticizer. It is also disclosed that the rosin also includes maleic anhydride rosin or rosin salt. It is further disclosed that the ink is used in dry lithography (col.1, lines 5-6, col.3, lines 63-65, and col.4, lines 10 and 31-39). Given that Krishnan et al. '022 disclose composition identical to that presently claimed, it is clear that the composition would intrinsically be water-washable.

The difference between Krishnan et al. '022 and the present claimed invention is the requirement in the claims of amount of acid neutralizing agent, i.e. monoethanolamine.

It is noted that Krishnan et al. '022 disclose the use of 3.8% monoethanolamine, while the present claims require "about 5%" monoethanolamine.

It is apparent, however, that the instantly claimed amount of monoethanolamine and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

In light of the case law cited above and given that there is only a "slight" difference between the amount of monoethanolamine disclosed by Krishnan et al. '022 and the amount disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of monoethanolamine disclosed in the present claims is but an obvious variant of the amount disclosed in Krishnan et al. '022, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

6. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Krishnan et al. '022 (U.S. 6,444,022) in view of *Hawley's Condensed Chemical Dictionary*

Attention is drawn to example 2 of Krishnan et al. '022 that disclose lithographic composition comprising (i) 60% carbon black base comprising 40% carbon black, 20% rosin ester, and 3% monoethanolamine, (ii) 20% modified linseed oil comprising 27.94% polyethylene glycol and 16.2% phthalic anhydride, (iii) 25% latex, and (iv) 2% monoethanolamine. From this example, it is calculated that the ink comprises approximately 24% carbon black, 12% rosin ester, 3.8% monoethanolamine, 5.6% polyethylene glycol, 3.24% phthalic anhydride, and 25% latex. It is well known, as evidenced by *Hawley's Condensed Chemical Dictionary* (pages 878-879), that phthalic anhydride functions as a plasticizer. It is also disclosed that the rosin also includes maleic anhydride rosin or rosin salt (col.1, lines 5-6, col.3, lines 63-65, and col.4, lines 10 and 31-39). Given that Krishnan et al. '022 disclose composition identical to that presently claimed, it is clear that the composition would intrinsically be water-washable.

The difference between Krishnan et al. '022 and the present claimed invention is the requirement in the claims of (a) amount of acid neutralizing agent, i.e. monoethanolamine and (b) amount of rosin-based resin.

With respect to difference (a), it is noted that Krishnan et al. '022 disclose the use of 3.8% monoethanolamine, while the present claims require "about 5%" monoethanolamine.

It is apparent, however, that the instantly claimed amount of monoethanolamine and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

With respect to difference (b), it is noted that Krishnan et al. '022 disclose the use of 12% rosin-based resin, while the present claims require "about 15%" rosin-based resin.

It is apparent, however, that the instantly claimed amount of rosin-based resin and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed

ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties”.

In light of the case law cited above and given that there is only a “slight” difference between the amount of monoethanolamine and the amount of rosin-based resin disclosed by Krishnan et al. ‘022 and the amounts disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of monoethanolamine and the amount of rosin-based resin disclosed in the present claims is but an obvious variant of the amounts disclosed in Krishnan et al. ‘022, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

7. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Krishnan et al. ‘022 (U.S. 6,444,022) in view of *Hawley’s Condensed Chemical Dictionary*

Attention is drawn to example 2 of Krishnan et al. ‘022 that disclose lithographic composition comprising (i) 60% carbon black base comprising 40% carbon black, 20% rosin ester, and 3% monoethanolamine, (ii) 20% modified linseed oil comprising 27.94% polyethylene glycol and 16.2% phthalic anhydride, (iii) 25% latex, and (iv) 2% monoethanolamine. From this example, it is calculated that the ink comprises approximately 24% carbon black, 12% rosin ester, 3.8% monoethanolamine, 5.6% polyethylene glycol, 3.24% phthalic anhydride, and 25% latex. It is well known, as evidenced by *Hawley’s Condensed Chemical Dictionary* (pages 878-879), that phthalic anhydride functions as a plasticizer. It is also disclosed that the rosin also includes maleic anhydride rosin or rosin salt (col.1, lines 5-6, col.3, lines 63-65, and col.4, lines

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10 and 31-39). Given that Krishnan et al. '022 disclose composition identical to that presently claimed, it is clear that the composition would intrinsically be water-washable.

The difference between Krishnan et al. '022 and the present claimed invention is the requirement in the claims of (a) amount of acid neutralizing agent, i.e. monoethanolamine and (b) "wet" lithographic printing ink.

With respect to difference (a), it is noted that Krishnan et al. '022 disclose the use of 3.8% monoethanolamine, while the present claims require "about 5%" monoethanolamine.

It is apparent, however, that the instantly claimed amount of monoethanolamine and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties".

In light of the case law cited above and given that there is only a "slight" difference between the amount of monoethanolamine disclosed by Krishnan et al. '022 and the amount disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of monoethanolamine disclosed in the present claims is but an obvious variant of the amount disclosed in Krishnan et al. '022, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

With respect to difference (b), while there is no disclosure that the ink is a “wet” lithographic printing ink as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. “wet” lithographic printing ink, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art ink and further that the prior art structure which is ink identical to that presently claimed is capable of performing the recited purpose or intended use, and thus, one of ordinary skill in the art would have arrived at the present invention.

8. Claims 1 and 3-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. ‘646 (U.S. 5,725,646) in view of Takayama et al. (U.S. 6,313,066).

The rejection is adequately set forth in paragraph 13 of the office action mailed 2/9/06 and is incorporated here by reference.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. '646 in view of Takayama et al. as applied to claims 1 and 3-20 above, and further in view of Pennaz (U.S. 5,338,351).

The rejection is adequately set forth in paragraph 14 of the office action mailed 2/9/06 and is incorporated here by reference.

Response to Arguments

10. Applicants' arguments regarding Hayashi et al. (U.S. 6,699,312) and Incontro et al. (U.S. 4,973,617) have been fully considered but they are moot in view of the discontinuation of the use of these references against the present claims.

11. Applicants' arguments filed 8/9/06 have been fully considered but, with the exception of arguments relating to Hayashi et al. and Incontro et al., they are not persuasive.

Specifically, applicants argue that in light of applicants' amendment filed 8/9/06, Krishnan et al. '022 is no longer an anticipatory reference against the present claims.

It is agreed that Krishnan et al. '022 is no longer a proper reference against the present claims under 35 USC 102 which is why Krishnan et al. is now applied against the present claims under 35 USC 103 as set forth in paragraphs 5-7 above.

Applicants argue that Krishnan et al. '022 is not a relevant reference against the present claims under 35 USC 103 either given that there is no disclosure in Krishnan et al. '022 of water-washable ink wherein the acid neutralizing agent is present in amount of about 5 wt.% to about 15 wt.%.

However, while applicants argue that the ink of Krishnan et al. '022 is not water-washable, applicants have offered no evidence to support their position. Thus, the examiner's position remains that while there is no explicit disclosure in Krishnan et al. '022 that the ink is water-washable, given that Krishnan et al. '022 disclose composition as presently claimed, i.e. comprising pigment, rosin-based resin, alcohol, acid neutralizing agent, plasticizer, and latex emulsion as presently claimed, it is clear that the composition would intrinsically be water-washable as presently claimed.

Further, with respect to the amount of acid neutralizing agent, attention is drawn to example 2 of Krishnan et al. '022 that discloses ink prepared from 60% black base comprising 3% monoethanolamine, i.e. acid neutralizing agent, and an additional 2% monoethanolamine and thus, the ink comprises in total 3.8% monoethanolamine.

Thus, while the present claims require "about 5%" monoethanolamine, Krishnan et al. '022 disclose the use of 3.8% monoethanolamine.

However, it is apparent, however, that the instantly claimed amount of monoethanolamine and that taught by Krishnan et al. '022 are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not

“render the claims patentable” or, alternatively, that “a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties”.

In light of the case law cited above and given that there is only a “slight” difference between the amount of monoethanolamine disclosed by Krishnan et al. ‘022 and the amount disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the amount of monoethanolamine disclosed in the present claims is but an obvious variant of the amount disclosed in Krishnan et al. ‘022, and thereby one of ordinary skill in the art would have arrived at the claimed invention.

Applicants argue that Krishnan et al. ‘646 is not a relevant reference against the present claims given that there is no disclosure in Krishnan et al. ‘646 of water-washable ink wherein the acid neutralizing agent is present in amount of about 5 wt.% to about 15 wt.%.

However, while applicants argue that the ink of Krishnan et al. ‘646 is not water-washable, applicants have offered no evidence to support their position. Thus, the examiner’s position remains that while there is no explicit disclosure in Krishnan et al. ‘646 that the ink is water-washable, given that Krishnan et al. ‘646 disclose composition as presently claimed, i.e. comprising pigment, rosin-based resin, alcohol, acid neutralizing agent, plasticizer, and latex emulsion as presently claimed, it is clear that the composition would intrinsically be water-washable as presently claimed.

Further, with respect to the amount of acid neutralizing agent, it is noted that col.3, lines 15-27 and 46 of Krishnan et al. ‘646 discloses that the ink comprises 10-70% binder comprising

0-5% water-soluble macromolecular binder such as polyethyleneimine, i.e. up to 3.5%, which is identical to the presently claimed acid neutralizing agent. Further, example 1 of Krishnan et al. '646 discloses that the ink additionally contains 2% monoethanolamine, i.e. acid neutralizing agent. Thus, it is clear that Krishnan et al. '646 disclose ink comprising amount of neutralizing agent, i.e. 5.5% (3.5 + 2), that falls within the scope of the present claims. It is noted that the ink of example 1 does not comprise the use of polyethyleneimine or alcohol solvent, however, the example does disclose the use of hydroxypropylcellulose and hydroxyethylene urea. In light of the disclosures in col.3, lines 44-46 and col.4, lines 10-12 of Krishnan et al. '646 of the equivalence and interchangeability of using hydroxypropylcellulose with using polyethyleneimine and of the equivalence and interchangeability of using hydroxyethylene urea with using ethylene glycol, i.e. alcohol solvent, it therefore would have been obvious to one of ordinary skill in the art to use polyethyleneimine and ethylene glycol in ink of example 1 wherein such ink would possess, for instance, 5.5% (3.5 + 2) acid neutralizing agent which amount falls within the scope of the present claims.

In light of the above, it is the examiner's position that Krishnan et al. '646 remains a relevant reference against the present claims.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dimotakis et al. (U.S. 2006/0211790) disclose water-washable lithographic ink comprising rosin resin, pigment, neutralizing agent, alcohol, and plasticizer, however, there is no

disclosure or suggestion that the ink comprises rosin-based resin and latex emulsion as presently claimed.

Klein et al. (U.S. 7,018,453) disclose water-washable lithographic ink comprising polymer latex, plasticizer, and rosin, however, there is no disclosure of neutralizing agent or alcohol solvent as presently claimed. Further, given the effective filing date of the reference, Klein et al. is not applicable against the present claims under any subsection of 35 USC 102.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

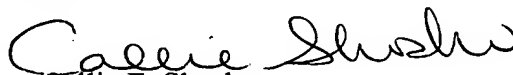
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
10/23/06